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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,724	12/20/1999	PETER SONDEREGGER	030708-035	7613

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EXAMINER

CHERNYSHEV, OLGA N

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 07/11/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/403,724

Applicant(s)

SONDEREGGER, PETER

Examiner

Olga N. Chernyshev

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16, 19, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 19, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 13, 2002 has been entered.
2. Claims 16, 19, 31 and 32 are pending in the instant application.  
Claims 16, 19, 31 and 32 are under examination in the instant office action.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 16, 19, 31 and 32 are rejected under 35 U.S.C. 101 because the claimed invention is drawn to an invention with no apparent or disclosed specific and substantial credible utility. The instant application has provided a description of isolated polypeptides, neurotrypsin of the human and neurotrypsin of the mouse. The instant application does not disclose the biological role of these proteins or their significance.

It is clear from the instant application that the proteins described therein are what is termed "orphan proteins" in the art. The DNA of the instant application has been isolated

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because of its similarity to a known DNA. There is little doubt that, after complete characterization, this DNA and encoded protein may be found to have a specific and substantial credible utility. This further characterization, however, is part of the act of invention and until it has been undertaken, Applicant's claimed invention is incomplete. The instant situation is directly analogous to that which was addressed in *Brenner v. Manson*, 148 U.S.P.Q. 689 (Sus. Ct, 1966), in which a novel compound which was structurally analogous to other compounds which were known to possess anti-cancer activity was alleged to be potentially useful as an anti-tumor agent in the absence of evidence supporting this utility. The court expressed the opinion that all chemical compounds are "useful" as it appears in 35 U.S.C. § 101, which requires that an invention must have either an immediate obvious or fully disclosed "real world" utility. The court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and "a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion".

The instant claims are drawn to an isolated neurotrypsin of the human and an isolated neurotrypsin of the mouse of as yet undetermined specific biological significance. It is clear from the instant specification that "[n]eurotrypsin is a newly discovered serine protease, which is predominantly expressed in the brain and in the lungs; the expression in the brain takes place nearly exclusively in the neurons" (page 1, lines 12-14 of the instant specification). It is further submitted that "the sequences of so-called primer oligonucleotides for the polymerase chain

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reaction were determined” “[b]y means of an alignment of the protease domains of 7 known serine proteases (tissue-type plasminogen activator, urokinase-type plasminogen activator, thrombinm plasmin, trypsin, chymotrypsin and pancreatic elastase)” (page 4, lines 22-26). Therefore, based on the structural similarities to different known serine proteases with well established specific and, in case of each of seven proteases, different function, it has been suggested that the neurotrypsins of the instant invention would also possess similar biological activity, which is the activity of serine protease. However, numerous publications exist on a topic of predicting protein functions from structural similarities or homology to the known proteins. It is well described in the art that amino acid structure cannot necessarily predict the function of the protein: “Knowing the protein structure by itself is insufficient to annotate a number of functional classes and is also insufficient for annotating the specific details of protein function” (see Skolnick et al., Box 2 on page 36 and the whole paper). Therefore, according to the state of the art, functional characteristics of a protein cannot be unequivocally extrapolated from its structural characteristics.

Moreover, in the absence of knowledge of the biological significance of this specific neurotrypsin protein, there is no immediately obvious patentable use for the claimed polypeptide. According to the specification of the instant application “the inventive compounds [...] are expressed in the adult nervous system predominantly in neurons of those regions that are thought to play an important role in learning and memory functions. [...] the expression pattern allows the assumption that the proteolytic activity of neurotrypsin has a role in structural reorganization in connection with learning and memory operations, for example operations which are involved in the processing and storage of learning behaviors, learning emotions, or memory contents”

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(page 14, lines 8-15). The instant specification fails to provide any evidence or sound scientific reasoning about a specific role of the claimed neurotrypsins in "learning behaviors, learning emotions, or memory contents". Therefore, without knowledge of a specific biological significance of the claimed peptides, one would not know how to prevent or treat a condition or disease associated with "learning behaviors, learning emotions, or memory contents" by administering these peptides or antagonists and agonists thereto. To employ neurotrypsins of the instant invention "as a possible target for a pharmacological intervention in diseases in which cell death occurs" (page 14, lines 33-35) would clearly be using them as the object of further research, which has been determined by the courts to be a utility, which, alone, does not support patentability. Since the instant specification does not disclose a credible "real world" use for the neurotrypsin proteins then the claimed invention is incomplete and, therefore, does not meet the requirements of 35 U.S.C. § 101 as being useful.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16, 19, 31 and 32 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention is not supported by either a clear asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 16, 19, 31 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claims 16 and 19 are indefinite and confusing for reciting "[i]solated neurotrypsins", as in claim 16 or "isolated proteins", as in claim 19. The claims appear to be directed to a mixture of polypeptides. Clarification is required.
7. Claim 32 is vague and indefinite for recitation "by purification of a natural source". Perhaps, the claim could be made clear by using the expression "by purification from a natural source".
8. Claim 31 is indefinite for being dependent from an indefinite claim.

### ***Conclusion***

9. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 782-9306 for regular communications and (703) 782-9307 for After Final communications.

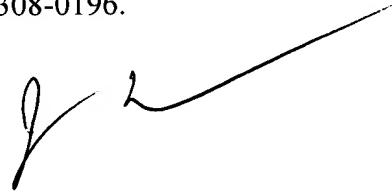
Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)0. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Olga N. Chernyshev, Ph.D.  
July 10, 2002

*OC*

  
JOHN ULM  
PRIMARY EXAMINER  
GROUP 1600